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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,548	06/14/2001	L. Lawrence Chapoy	7651/1610	6814

7590

04/23/2003

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EXAMINER

COLLINS, DARRYL J

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/881,548

Applicant(s)

CHAPOY ET AL.

Examiner

Darryl J. Collins

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION*****Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show a contact lens having the eccentricity as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Information Disclosure Statement***

The Examiner has considered most of the references submitted as part of the Information Disclosure Statement, but has not found any to be particularly relevant. If Applicant is aware of pertinent passages, he should so state in the response to this Office action. (See 26 USPQ2d 1889; *Molins PLC v. TEXTRON, Inc.*, DC/DEL. 11/24/92).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 (dependent claims 13-15), 16 (dependent claims 17-23), 24 (dependent claims 25-29) and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 12 recites the limitation "the angle  $\phi$ " in line 9, page 14, claim 16 recites the limitation "the angle  $\phi$ " in line 22, page 14, claim 24 recites the limitation "the angle  $\phi$ " in line 21, page 15 and claim 30 recites the limitation "the angle  $\phi$ " in line 16, page 16. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4 –10, 12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhang (USPN 5408281). Zhang teaches a multi-focal contact lens wherein the lens provides a plurality of different dioptric powers along spiral like patterns on the aspheric front surface (16) of the lens as claimed in independent claim 1 and dependent claim 2 (column 4, lines 12-13). Figure 2 of Zhang teaches the dioptric power varying along an arc located at a predetermined distance from the lens center and does so for at least 180° as claimed in dependent claims 1 and 6. Zhang also discloses the varying power to extend into the lower portion of the lens as claimed in dependent claim 4, the side portion of the lens as claimed in dependent claim 8, as well as a second area spanning the top portion of the lens having "substantially constant power" as claimed in dependent claims 5 and 9 (Figure 2). Zhang further teaches a contact lens having a top portion having minimum power and a lower portion having a maximum power (e.g., a

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bifocal lens) as claimed in dependent claims 7 and 10 (column 2, lines 12-13). Still further, Zhang teaches a lens having an eccentricity, which varies as an angular function, wherein the angle is measured in the plane of the contact lens as claimed in independent claims 12 and 16 (figure 3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang in view of Perrott (USPN 5771088). Zhang teaches all the claimed limitations of independent claim 1 as discussed above, but fails to teach an aspheric back surface. Perrott teaches a multi-focal lens wherein both the front surface and rear surface are aspheric (column 3, lines 63-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known aspheric surfaces of Perrott in the construction of the multi-focal contact lens of Zhang for reducing the spherical aberration in the eye of the user.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang in view of Bernstein (USPN 6109749). Zhang teaches all claimed limitations of claim 11 with the exception of the lens having an optical axis and a geometrical center being offset from the optical axis. Bernstein teaches a bifocal contact lens having a varying optical power gradient wherein the optical axis and geometrical axis are offset (column 2, line

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34-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known offset technique of Bernstein in the construction of the multi-focal contact lens of Zhang for the purpose of reducing lens translation.

***Allowable Subject Matter***

Claims 13-15 and 18-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the independent claims, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. A combination of all the claimed features, in particular the constraints on the eccentricity of the aspheric surface as presented in claim 13 and dependent claims 14 and 15, are not taught by the prior art. The distinct range for the maximum corrections power as presented in claim 19 and dependent claims 20-23, is neither taught or fairly suggested by the prior art.

Claims 24-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the independent claims, in such a manner that a rejection under

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35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented. In independent claim 24, the prior art fails to teach a contact lens having multiple and distinct eccentricities within the top, bottom and side portions of an aspheric surfaced contact lens. In independent claim 30, the prior art fails to specifically and distinctly teach the numerical limitations defining the near correction and distant correction power regions.

### *Conclusion*

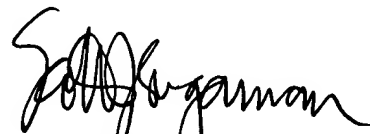
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl J. Collins whose telephone number is 703-308-6476. The examiner can normally be reached on 6:30 - 5:00 Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on 703-308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



djc  
April 16, 2003



Scott J. Sugarman  
Primary Examiner